

## **REMARKS**

The Office Action dated June 2, 2005 has been received and carefully studied.

As an initial matter, it has come to Applicant's attention that the term "ring finger" was inadvertently used to designate the third or middle finger of the hand, whereas conventionally this term is used to designate the fourth finger of the hand. Accordingly, by the accompanying amendment, the specification and claims have been amended to recite "third finger" rather than ring finger, to clarify the positioning of the shaft. The drawings clearly show that the third finger was intended; indeed, it would be impossible for the shaft to exit between the index finger and the fourth finger.

The Examiner objects to the drawings for failure to show the target side hand above the second hand, as described in claim 31. By the accompanying amendment, claim 31 has been cancelled. It is believed that such cancellation renders the objection moot.

The Examiner rejects claims 1-34 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner states that sports methods are not "useful arts" within the meaning of the U.S. Constitution. The Examiner also rejects these claims under 35 U.S.C. §112, first paragraph for the same reason.

The rejections are respectfully traversed.

Applicant vigorously disagrees with the Examiner's interpretation of the Constitution and attempted analogy to cases that concern the patentability of life forms and algorithms. The Examiner's unilateral conclusion that holding a golf

club or striking a golf ball are not within the phrase "useful arts" as it appears in the Constitution is unsupported and in fact is contradictory to the position of the Patent Office as evidenced by numerous patents *cited by the Examiner* which contain similar claims. See, for example, claim 1 of U.S. Patent No. 5,913,738:

"1. A method for putting a golf ball, comprising the steps of:  
gripping a putter such that both forearms of a player using the  
putter are parallel to a putting surface;  
taking a backswing by rotating an upper body of the player  
without wrist and elbow movement;  
taking a downswing by rotating the upper body of the player  
without wrist and elbow movement;  
striking the golf ball."

See also claim 1 of U.S. Patent No. 5,616,089 cited by the Examiner, as well as the entire subclass 473/409.

The methods claimed in the instant application produce a useful, concrete and tangible result, and fall within the scope of 35 U.S.C. §§101 and 112. Withdrawal of the rejections is respectfully requested.

The Examiner rejects claims 1, 2, 4 and 7-12 under 35 U.S.C. §102(b) as being anticipated by Collins, U.S. Patent No. 5,785,608, and claims 13, 14, 16, 19-23 and 25-29 as being unpatentable over Collins. The Examiner states that Figure 8 of Collins shows the club shaft 74 positioned in the armpit area of a player with the target side hand and other hand also gripping the shaft.

The rejections are respectfully traversed.

Collins expressly states that Figure 8 shows the end of the putter positioned between the user's forward arm and ribs, not the armpit or front of the shoulder as required by the instant claims. Wedging the club against the ribs as taught by Collins is completely different from the instant method that is designed to maintain

the torso out of the swing (allowing the arm, hinged at the shoulder, to operate independently as a pendulum). Wedging the club against the ribs requires torso involvement. Nowhere does Collins suggest the instantly claimed methods.

The Examiner rejects claims 3 and 15 under 35 U.S.C. §103(a) as being unpatentable over Collins in view of Shioda, U.S. Patent Appln. Publication No. 2004/0166956, claims 5 and 17 as being unpatentable over Collins in view of Carlucci, U.S. Patent No. 5,913,738, and claims 6 and 18 as being unpatentable over Collins in view of Miller, U.S. Patent No. 5,616,089.

The rejections are respectfully traversed.

These rejections fail since Collins does not show positioning the club in the armpit or front of the shoulder as mentioned above. The secondary references do not supply this critical deficiency of Collins.

The Examiner rejects claims 30-33 under 35 U.S.C. §102(e) as being anticipated by Shioda, and claim 34 as being unpatentable over Shioda. The Examiner states that Shioda discloses the grip style recited in these claims.

In order to expedite allowance, claim 31 has been cancelled.

The rejections of claims 30, 32, 33 and 34 are respectfully transversed.

The two critical elements of Applicant's claim 30 and the related remaining dependent claims are that the club (a) exits the target side hand between the index and third finger, and (b) **enters the target side hand at the top of the palm, traveling along the so-called life line.** As shown in Applicant's Figures 5A and 5B, this means that the club is positioned between the pad beneath the thumb (the "thumb pad") and the pad beneath the pinkie finger (the "pinkie pad") of the target


side hand. Applicant admits that Figures 14, 16, 19, 20, 21 and 22 of Shioda show the club being gripped between the index and third finger. However, Shioda, both in its specifications, drawings and claims, discloses or teaches nothing about where the club enters the hand. Applicant contends that, as shown in Shioda Figures 14, 20 and 21, rather than traveling along the life line through the top of the palm, the club is gripped more in the third, fourth and fifth fingers, and enters the hand across or beneath the pinkie pad, or, as shown in Figure 15 and 23, is not held against the top or side of the hand at all. As further evidence, please note that the pinkie pad is clearly visible in Applicant's Figure 5B, but is nowhere visible in any Shioda figure where the club is gripped between the second and third finger. If Shioda taught the club entering from the top of the palm as Applicant does, the pinkie pad would be clearly visible in those drawings.

The functional differences between these variations in grip are of critical importance to Applicant's invention. As taught by Applicant, having the club enter the target side hand from the top of the palm and exit between the second and third finger causes the back of the target side hand to more readily align perpendicular to the target line, allowing the golfer to direct the club along the target line by pulling with the back of the target side hand. This method also reduces involvement of the other hand, and can reduce variation in wrist angle. Shioda relies on mechanical means (the shape of the putter grip and the interaction of the hand therewith) for promoting alignment of the club along the target line; is conventional in its approach to wrist angle, and does nothing to reduce the involvement of the other hand in the swing.

The remaining prior art is believed to have been properly not relied upon in rejecting any claim.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,

  
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